

**REMARKS**

Claims 1-22 are pending in the application, and were each rejected. Reconsideration of the claims is respectfully requested.

The specification is amended above.

**I. CLAIM REJECTIONS -- 35 U.S.C. § 101**

Claims 16-22 were rejected under 35 U.S.C. § 101 because the claims invention is directed to non-statutory subject matter.

In the interest of furthering prosecution, the specification is amended to remove the reference to signal bearing media. This rejection is believed obviated.

Applicant notes, however, that neither the MPEP nor the “Interim Guidelines” has the force or effect of law, and they are clearly incorrect on this point. It is well established that a process is statutory if it requires that measurements of physical objects or activities, occurring outside of the computer, be transformed into computer data, and that the computer data itself be transformed (*In re Gelnovatch*, 595 F.2d 32, 41 n.7, 201 USPQ 136, 145 n.7 (CCPA 1979) (data-gathering step did not measure physical phenomenon); *Arrhythmia Research Tech. v. Corazonix Corp.*, 958 F.2d 1053 at 1056, 22 USPQ2d 1033 at 1036 (Fed. Cir. 1992)). This rule has been applied where the data comprises signals corresponding to or representing physical objects or activities external to the computer system, and where the process causes a physical transformation of those signals. *In re Schrader*, 22 F.3d 290 at 294, 30 USPQ2d 1455 at 1459 (Fed. Cir. 1994) citing with approval *Arrhythmia*; *In re Abele*, 684 F.2d 902 at 909, 214 USPQ 682 at 688 (CCPA 1982); *In re Taner*, 681

F.2d 787, 790, 214 USPQ 678, 681 (CCPA 1982); *In re Alappat* 33 F. 3d 1526, 31 USPQ2d 1545 (Fed. Cir. 1994). The Federal Circuit recognizes that signals are manufactures, “[t]he view that ‘there is nothing necessarily physical about ‘signals’ is incorrect.” (*Arrhythmia*, 958 F2d at 1059, 22 USPQ 2d at 1038).

Applicant recognizes that the Office attempts to ignore and rewrite the relevant law by use of the “Interim Guidelines” and revisions shown in Revision 5 of the Eighth Edition of the MPEP. Applicant respectfully notes that the MPEP itself states in its Foreword (emphasis added):

This Manual is published to provide U.S. Patent and Trademark Office (USPTO) patent examiners, applicants, attorneys, agents, and representatives of applicants with a reference work on the practices and procedures relative to the prosecution of patent applications before the USPTO. It contains instructions to examiners, as well as other material in the nature of information and interpretation, and outlines the current procedures which the examiners are required or authorized to follow in appropriate cases in the normal examination of a patent application. The Manual does not have the force of law or the force of the rules in Title 37 of the Code of Federal Regulations.

Accordingly, the Applicant respectfully requests the Examiner to withdraw the § 101 rejection.

### **CLAIM REJECTIONS -- 35 U.S.C. §102**

Claims 1-22 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,675,803 to *Preisler, et al.*, hereinafter “Preisler”. This rejection is respectfully traversed.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131, p. 2100-76 (8th ed., rev. 4, October 2005) (*citing In re Bond*, 910 F.2d

831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990)). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. *Id.* (*citing Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987)).

Preisler does not teach or suggest the claimed first, second, and third program code. Preisler appears disclose an original program 302 and an in-memory copy 308, the “instrumented program”. The in-memory program 308 can be patched during execution to become the instrumented program.

Assuming, *arguendo*, that Preisler’s original program 203 corresponds to the claimed first program code, and the Preisler’s patched instrumented program corresponds to the claimed second program code, it is clear the nothing in Preisler corresponds to the claimed third program code, wherein one of the modified program components (of the second program code) is replaced with a corresponding one of the verified program components (of the first program code).

The Examiner refers to Preisler’s col. 5, lines 20-25:

This in-memory copy of the program 302 changes to a patched program, called "instrumented program" herein. The patches are applied only to this in-memory copy 308 of the program 302 and not to the original program 302 stored on disk 301.

As can be seen, there is no teaching or suggestion that any modified program component (i.e., the patches) of the instrumented program are replaced with a corresponding one of any program components of program 302, as required by claims 1, 9, and 16. Preisler therefore cannot teach or suggest all limitations of the claims, and does not anticipate the claims.

**DOCKET NO. 05-03-008  
SERIAL NO. 10/706,849  
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The rejections of all independent claims are therefore traversed, and so the rejections of the corresponding dependent claims are likewise traversed.

Accordingly, the Applicant respectfully requests the Examiner to withdraw the § 102 rejection with respect to these claims. The Examiner is cordially requested to telephone the undersigned to resolve any issues remaining before allowance.

**CONCLUSION**

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *manderson@munckbutrus.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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